

**REMARKS**

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1 and 3-14 are now present in this application. Claims 1, 7 and 8 are independent.

Claim 2 has been canceled, and claims 1 and 6-8 have been amended. No new matter is involved. Reconsideration of this application, as amended, is respectfully requested.

**Priority Under 35 U.S.C. § 119**

Applicant thanks the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

**Information Disclosure Citation**

Applicant thanks the Examiner for considering the references supplied with the Information Disclosure Statement filed June 9, 2004, and for providing Applicant with an initialed copy of the PTO-1449 form filed therewith.

Rejection Under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph

Claims 6 and 7 stand rejected under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph.  
This rejection is respectfully traversed.

The Examiner indicates that, in claim 6, lines 2-3, "when the lever is rotated downwardly" lacks antecedent basis to establish structure to accomplish this.

In order to overcome this rejection, Applicant has amended claim 6 to recite a combination of features, including --wherein the sensing part includes a switch generating a rotation motor control signal by being in contact with a lower part of the lever when the lever is rotated downwardly and coupled with the latch --. Applicant respectfully submits that this amendment overcomes the basis of this rejection by now reciting a switch being in contact with a lower part of the lever when the lever is rotated downwardly and coupled with the latch.

Applicant respectfully submits that the claims, as amended, particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Rejection Under 35 U.S.C. § 102

Claims 1, 3, 5 and 6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 3,462,584 to Guy. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Claim 1 is amended to positively recite a combination of features wherein the rotation motor is formed of a step motor. Claims 3, 5 and 6 depend from claim 1 and, therefore, also recite the feature of a step motor. Guy's motor 54 is not disclosed a step motor.

Accordingly, Guy does not anticipate claims 1, 3, 5 and 6.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Rejections under 35 U.S.C. § 103

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Guy in view of U.S. Patent 6,147,622 to Fonea. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

This rejection is moot in one sense because claim 2 has been canceled. However, because the feature of claim 2 has been added to claim 1, this rejection will be treated as a rejection of the subject matter of claim 1, as amended.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole", not just a few features of the claimed invention. Under 35 U.S.C. §103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. See Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148

USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

The Office Action admits that Guy does not disclose a step motor. In an attempt to overcome this deficiency, the Office Action turns to Fonea, which discloses an electronic lock system which deactivates itself when the lock is obstructed, automatically corrects any problems of misalignment, and uses a sophisticated control system 56 made up of a number of modules, including software modules (col. 6, lines 31-67) that provide highly effective diagnostic functions. As disclosed in col. 7, lines 1-12, on initial installation, the lock system performs a calibration procedure in which it generally determines at least three to five reference positions for subsequent monitoring. The positions are determined in terms of the number of pulses or cycles of the electrical supply to bidirectional stepper motor 14 required to move central axle 16, which is mechanically engageable with a drive gear 18 of a lock cylinder, and lock mechanism between various detectable states.

The Office Action states that it would be obvious to use a step motor in the lock mechanism of Guy to enhance precision of motor rotation and, hence, lock operation.

Applicant respectfully disagrees with this statement and respectfully submits that the Office Action fails to make out a *prima facie* case of proper motivation to modify Guy to provide Fonea's stepper motor in Guy.

In the first place, the Office Action fails to demonstrate that Guy's analog range oven door latching system has any problems that would motivate one of ordinary skill in the range oven door latching system art to redesign Guy's analog system and make it a digital system with a digital stepper motor and sophisticated electronic control system that employs many software modules.

In the second place, Guy's system uses a motor that does not reverse direction. It simply rotates in the same direction and uses a cam 58 to latch and unlatch the oven door while rotating in the same direction. Fonea, on the other hand, requires a reversing type motor to lock and unlock its far more complicated lock mechanism. This fundamental difference between Guy and Fonea would actually teach away from modifying Guy by replacing Guy's unidirectional analog motor with a bidirectional stepper motor that requires a sophisticated digital controller. In other words, one of ordinary skill in the art would not be motivated to turn to a highly sophisticated reversible stepper motor to replace a simple unidirectional motor where there is no need in Guy for a

reversible motor or for plural different accurate position determinations.

In the third place, one would have to completely throw out the analog circuitry of Guy and completely redesign the control circuits with sophisticated digital circuitry to accomplish the proposed modification of Guy. The need to perform such a drastic redesign of Guy would teach away from making the proposed modification of Guy in view of Fonea.

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. See United States v. Adams, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966); W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1550-51, 220 USPQ 303,311 (Fed. Cir. 1983) (the totality of a reference's teachings must be considered), cert. denied, 469 U.S. 851 (1984); In re Sponnoble, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969); In re Caldwell, 319 F.2d 254, 256, 138 USPQ 243, 245 (CCPA 1963) and In re Gurley, 31 USPQ2d 1130 (Fed. Cir. 1994).

In view of these considerations, Applicant respectfully submits that the Office Action is based either on unwarranted speculation, which is not a proper basis on which to reject claims, or improper hindsight reconstruction of Applicant's claimed invention based solely on Applicant's disclosure.



Accordingly, Applicant respectfully submits that the Office Action has not made out a *prima facie* case that claim 1, which has been amended to recite the features of originally filed claim 2, is obvious over the applied Guy and Fonea references.

Claims 1-6 stand rejected under 35 U.S.C. §103(a) as unpatentable over French Patent document 2,521,274 to Michel et al. (hereinafter, "Michel") in view of Fonea. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Initially, Applicant notes that attached hereto is an English language translation of Michel which Applicant's undersigned representative obtained on December 28, 2004 by downloading the specification and claims of Michel from the French Patent Office's website and translated using the Google web site's free translation services. Applicant does not vouch for the accuracy of the translation but submits it in the interest of making it easier for Applicant and the Examiner to understand the full disclosure of the Michel reference.

The Office Action admits that Michel does not disclose a step motor. In an attempt to overcome this deficiency, the Office Action turns to Fonea, which discloses an electronic lock system which deactivates itself when the lock is obstructed, automatically corrects any problems of misalignment, and uses a sophisticated control system 56 made up of a number of modules, including

software modules (col. 6, lines 31-67) that provide highly effective diagnostic functions. As disclosed in col. 7, lines 1-12, on initial installation, the lock system performs a calibration procedure in which it generally determines at least three to five reference positions for subsequent monitoring. The positions are determined in terms of the number of pulses or cycles of the electrical supply to bidirectional stepper motor 14 required to move central axle 16, which is mechanically engageable with a drive gear 18 of a lock cylinder, and lock mechanism between various detectable states.

The Office Action states that it would be obvious to use a step motor in the lock mechanism of Michel to enhance precision of motor rotation and, hence, lock operation.

Applicant respectfully disagrees with this statement and respectfully submits that the Office Action fails to make out a *prima facie* case of proper motivation to modify Michel to provide Fonea's stepper motor in Michel.

In the first place, the Office Action fails to demonstrate that Michel's analog range oven door latching system has any problems that would motivate one of ordinary skill in the range oven door latching system art to redesign Michel's analog system and make it a digital system with a digital stepper motor and sophisticated electronic control system that employs many software modules. There is no indication in Michel that Michel's motor rotation needs enhanced precision. Nor has the Office Action provided any objective factual

evidence that there is such a need in the relatively simple device of Michel. All that is presented in this regard is speculation.

As is well settled, a rejection based on Section 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the Examiner has the initial duty of supplying the factual basis for the rejection advanced. An Examiner may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

In the second place, while Michel's system uses a motor that rotates in one direction or the other, there are only two positions of significance disclosed, each position being 180 degrees out of phase with the other. Note, in this regard, the disclosure of rotating the cam a half turn in the direction of arrow R on page 3, lines 11-16, the locked position shown in Fig. 1 and the unlocked position shown in Fig. 3. Fonea, on the other hand, requires a digitally controlled reversing type motor to not only lock and unlock its far more complicated lock mechanism, but also to perform a calibration procedure in which it generally determines at least three to five reference positions for subsequent monitoring. The positions are determined in terms of the number of pulses or cycles of the electrical supply to bidirectional stepper motor 14 required to move central axle 16, which is

mechanically engageable with a drive gear 18 of a lock cylinder, and lock mechanism between various detectable states. Michel does not need such a sophisticated locking mechanism with a digital controller. This fundamental difference between Michel and Fonea would actually teach away from modifying Michel by replacing Michel's simple two position motor with a bidirectional stepper motor that requires a sophisticated digital controller. In other words, one of ordinary skill in the art would not be motivated to turn to a highly sophisticated reversible stepper motor to replace a simple unidirectional motor where there is no need in Michel for the numerous accurate position determinations required for calibration in Fonea.

In the third place, one would assume that the vintage 1982 control circuitry of Michel was analog circuitry that would have to be completely redesigned with sophisticated digital circuitry to accomplish the proposed modification of Michel. Moreover, all that Michel discloses by way of control is a user button, which clearly does not require the sophisticated control circuitry of Fonea to operate. The need to perform a drastic redesign of Michel would teach away from making the proposed modification of Michel in view of Fonea.

Accordingly, Applicant respectfully submits that the Office Action has not made out a *prima facie* case that claims 1-6 are obvious over the applied Michel and Fonea references.

Reconsideration and withdrawal of this rejection of claims 1-6 is respectfully requested.

*Allowable Subject Matter*

The Examiner states that claim 7 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph and be re-written in independent form.

Applicant thanks the Examiner for the early indication of allowable subject matter in this application. Claim 7 has been re-written in independent form and as set forth above in order to overcome the rejection under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph. Therefore, Applicant respectfully submits that claim 7 is allowable.

The Examiner states that claims 8-14 would be allowable if rewritten in independent form.

Applicant thanks the Examiner for the early indication of allowable subject matter in this application. Objected-to claim 8 has been rewritten into independent form, and should therefore be allowed. Also, claims 9-14 depend, either directly or indirectly, from independent claim 8, and are therefore allowable based on their dependence from claim 8 which is believed to be allowable.

*Additional Cited References*

Because the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

*Conclusion*

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

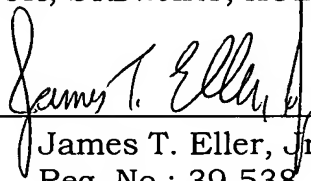
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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By:   
James T. Eller, Jr.  
Reg. No.: 39,538

JTE/RJW/adt 

P.O. Box 747  
Falls Church, Virginia 22040-0747  
Telephone: (703) 205-8000